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10/693,382	10/23/2003	John K. Solheim	KMC-604	1641

7590

05/18/2005

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EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/693,382

Applicant(s)

SOLHEIM ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not contain support for the club head to not have removable fasteners. An adhesive can be removable through the apertures by means of scraping, thinners, etc.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cameron et al. (USPN 6231458).

Regarding claim 1, Cameron et al. discloses a club head body composed of a first material wherein the club head body having a rear surface, a heel end, a toe end, and a front face with a first cavity formed therein. The first cavity being defined by a

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bottom wall and a side wall wherein the club head body further comprises a first aperture passing from the first cavity through the bottom wall thereof to the rear surface of the club head body wherein the first aperture is devoid of removable fasteners. The club head also comprises a face insert composed of a second material disposed within the first cavity and the face insert comprising a body with a front surface, a back surface and a lateral surface (See Figure 2, 13, and 15).

Regarding claim 2, Cameron et al. discloses an adhesive layer disposed in the first cavity immediately adjacent the bottom wall of the cavity and the back surface of the face insert to adhere the face insert to the cavity (See Figure 13 and 15, Column 3, lines 55 through 64; and Column 5, lines 11 through 13 and 21 through 30).

Regarding claim 3, Cameron et al. discloses a portion of the adhesive layer extending into the aperture (See Figure 15).

Regarding claim 4, Cameron et al. discloses a second cavity passing from the first cavity through the bottom wall to the rear surface of the club head body (See Figure 13 and 15).

Regarding claim 5, Cameron et al. discloses the aperture having an "O" shape which is an English alphabet.

Regarding claim 6, Cameron et al. discloses a second cavity formed in the back surface of the face insert (See Figure 8).

Regarding claim 7, Cameron et al. discloses a cavity insert composed of a third material disposed in the second cavity (See Figure 8).

Regarding claim 8, Cameron et al. discloses the cavity insert composed of an elastomeric silicone compound.

Regarding claim 10, Cameron et al. disclose the face insert having a continuous lip extending outward laterally of the face insert sized and shaped to form a close tolerance fit with the side wall of the first cavity and adapted to center the insert into the cavity (See Figure 23).

Claims 1, 2, 4, 11, 12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Boord (USPN 6729972).

Regarding claim 1, Boord discloses a club head body composed of a first material wherein the club head body having a rear surface, a heel end, a toe end, and a front face with a first cavity formed therein. The first cavity being defined by a bottom wall and a side wall wherein the club head body further comprises a first aperture passing from the first cavity through the bottom wall thereof to the rear surface of the club head body wherein the first aperture is devoid of removable fasteners. The club head also comprises a face insert **29** composed of a second material disposed within the first cavity and the face insert comprising a body with a front surface, a back surface and a lateral surface (See Column 3, lines 37 through 64, and Figure 2).

Regarding claim 2, Boord inherently discloses an adhesive layer disposed in the first cavity immediately adjacent the bottom wall of the cavity and the back of the face insert being that the face insert is adhered to the bottom wall of the cavity (see Figure 6).

Regarding claim 4, Boord discloses the club head body comprising a second aperture passing from the first cavity through the bottom wall to the rear surface of the club head body.

Regarding claim 11, 12, and 14, the method of assembly is implied as set forth above in claims 1 and 2.

Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher (USPN 5921871).

Regarding claim 11, Fisher inherently discloses a method of manufacturing a golf club comprising providing a club head body composed of a first material, the club head body having a rear surface and a front face with a cavity formed therein, the cavity being defined by a bottom wall and a side wall, the club head body further comprising an aperture passing from the cavity through the bottom wall thereof to the rear surface; providing a face insert composed of a second material, the face insert comprising a body having a front surface, a back surface and a lateral surface; applying an adhesive layer between the bottom wall of the cavity and the back surface of the face insert; and pressing the face insert into the cavity so that any air trapped between the face insert and the bottom wall of the cavity escapes through the aperture.

Regarding claim 12, Fisher inherently discloses pressing the face insert farther into the cavity until the adhesive layer comes into contact with and bonds to the back surface of the face insert and the bottom wall of the cavity.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (USPN 6231458).

Regarding claim 5, In the alternative, patentability cannot be granted on aesthetics. Cameron et al. discloses the apertures providing the same utility as that of the applicant's; therefore, it is submitted that the shape of apertures are an obvious matter of design choice.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (USPN 5921871).

Regarding claim 13, applicant does not state why it is critical for a portion of the adhesive layer to extruded through the aperture in order to attain the invention. Therefore, one having ordinary skill in the art would have found an obvious matter of design choice. The adhesive layer of Fisher would perform equally as well because it facilitates attachment of the face insert to the golf club head.

Regarding claim 14, Applicant does not state why it is critical for only injection to be used in order form the adhesive layer. Therefore, one having ordinary skill in the art would have found it obvious matter of design choice. The method of applying the adhesive layer taught by Fisher would perform equally as well because it facilitates the attachment of the face insert.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (USPN 5921871) in view of Grace et al. (USPN 5924939).

Regarding claim 15, Fisher does not disclose a cavity insert inserted into the face insert. Grace et al. discloses a golf club head having a face insert 7 wherein a cavity insert 6 is inserted into the face insert (See Figure 4 and Summary of the invention). One having ordinary skill in the art would have found it obvious to place a cavity insert within a face insert, as taught by Grace et al., in order to provide a soft feel to the golf club as well as aesthetics.

Regarding claim 16, Fisher discloses a golf club head comprising a club head body 21 composed of a first material wherein the club head body having a rear surface, a heel end, a toe end, and a front face 22 with a first cavity 44 formed thereon, the first cavity being defined by a bottom wall and a side wall 36 and 37, the club head body further comprising a first aperture 53 passing from the first cavity through the bottom wall thereof to the rear surface of the club head body, and a face insert 38 composed of a second material disposed within the first cavity wherein the face insert comprising a body with a front surface, a back surface and a lateral surface (See Figure 2). Fisher discloses the insert being visible through the aperture before inserting the screws but does not disclose a cavity insert inserted into the face insert. Grace et al. discloses a golf club head having a face insert 7 wherein a cavity insert 6 is inserted into the face insert (See Figure 4 and Summary of the invention). One having ordinary skill in the art would have found it obvious to place a cavity insert within a face insert, as taught by Grace et al., in order to provide a soft feel to the golf club as well as aesthetics.



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Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (USPN 5921871) in view of Grace et al. (USPN 5924939) further in view of Camerson et al. (USPN 6231458).

Regarding claim 17, Fisher discloses the first material being metal and the second material being a polymer but Fisher in view of Grace et al. does not disclose the third material being an elastomeric silicone compound. Cameron et al. discloses a golf club head having two insert wherein one of the inserts comprise an elastomeric silicone compound (See Column 3, lines 54 through 64). One having ordinary skill in the art would have found it obvious to have the cavity insert made of an elastomeric silicone compound, as taught by Cameron et al., in order to dampen the vibration of the club head during impact.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed with respect to claims 11-17 have been fully considered but they are not persuasive.

Regarding claim 11-15, Applicant argues that Fisher does not teach an adhesive layer between the front surface of the cavity in the club head body and the back surface of the face insert. The examiner disagrees. Applicant should look at the claim language and the prior art closely. Fisher shows an adhesive layer between the front surface of the club head body and the back surface of the face insert. The applicant

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does not require the adhesive layer to touch either of the two surfaces. The fact that the face insert is removable has nothing to do with the anticipation of claim 11.

Regarding claim 16 and 17, See the above regarding claim 11-15.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAA

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